

Appl. No. : 10/771,703
Filed : February 4, 2004

REMARKS

The foregoing amendments and the following remarks are responsive to the July 28, 2005 Office Action. Claims 1, 3, 5, 6, 8, and 9 are amended, Claims 2 and 4 are cancelled without prejudice, Claim 7 remains as originally filed, and Claims 10-14 are newly added. Thus, Claims 1, 3, and 5-14 are presented for further consideration.

Comments on Telephone Conversation on September 19, 2005

Applicant thanks Examiner Steven Wong for the telephone conversation on September 19, 2005 in which the Examiner explained that conversations with the Examiner were restricted because Applicant has an appointed representative. Applicant has decided to not arrange for a conference call with his attorney or to revoke the power of attorney at this time.

Response to Rejection of Claims 1 and 2 Under 35 U.S.C. § 102(b)

In the July 28, 2005 Office Action, the Examiner rejects Claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,783,077 issued to Lemon ("Lemon"). Applicant has cancelled Claim 2 without prejudice, reserving the right to pursue allowance of Claim 2 in a continuation application.

Claim 1

Claim 1 has been amended to recite (emphasis added):

1. A one-piece tee for supporting a golf ball, comprising an elongated body having a head on one end formed to receive and support a golf ball and having an end portion on its other end adapted to penetrate the ground to support the tee head at a desired height, the end portion having a cross-sectional area, a **first plurality of ribs** of the body extending along at least a **first portion** of the body adjacent to and spaced upwardly from the end portion, the **first portion** of the body including the **first plurality of ribs having a first constant cross-sectional area larger than the cross-sectional area of the end portion**, a first stop formed by the **first plurality of ribs** where the **first portion** of the body is adjacent to the end portion, the **first stop being constructed to enable a person to sense the increased penetration resistance encountered when the first stop engages the ground** so that a first depth of penetration will indicate the approximate amount of the tee extending above the first stop, which would be a desirable location for positioning the golf ball to be hit by a large head golf club, the first stop being further constructed such that the tee can be normally inserted further without difficulty to a second depth desirable for use with a golf club having a smaller head.

Applicant submits that the amendment is fully supported by the as-filed specification (see, e.g., Figure 1 and page 3, lines 19-24) and does not include new matter.

Appl. No. : 10/771,703
Filed : February 4, 2004

Applicant submits that Lemon does not disclose all the limitations of amended Claim 1. For example, Lemon does not disclose a tee having a “first plurality of ribs ... extending along at least a first portion ... adjacent to and spaced upwardly from the end portion, the first portion ... having a first constant cross-sectional area larger than the cross-sectional area of the end portion,” as recited by amended Claim 1. Furthermore, while Lemon discloses flutes having differing lengths from one another, Lemon does not disclose that the shorter flutes (e.g., flute 50 of Figure 3) engage the ground. Therefore, these shorter flutes do not provide a stop which is “constructed to enable a person to sense the increased penetration resistance encountered when the first stop engages the ground,” as recited by amended Claim 1.

Applicant submits that amended Claim 1 is patentably distinguished over Lemon. Applicant respectfully requests that the Examiner withdraw the rejection of amended Claim 1, and pass amended Claim 1 to allowance.

Response to Rejection of Claims 3-6, 8, and 9 Under 35 U.S.C. § 103(a)

In the July 28, 2005 Office Action, the Examiner rejects Claims 3-6, 8, and 9 under 35 U.S.C. § 103(a) as being unpatentable over Lemon in view of U.S. Patent No. 6,139,449 issued to Cardarelli (“Cardarelli”). Applicant has cancelled Claim 4 without prejudice, reserving the right to pursue allowance of Claim 4 in a continuation application.

Claims 3, 5, and 6

As described above, Applicant submits that Lemon does not disclose all the limitations of amended Claim 1. Applicant further submits that Cardarelli does not disclose or suggest the limitations of amended Claim 1 which are not disclosed or suggested by Lemon. Applicant also submits that there is no suggestion to combine the teachings of Lemon and Cardarelli. Therefore, amended Claim 1 is patentably distinguished over Lemon in view of Cardarelli.

Claim 3 has been amended to depend from amended Claim 1, Claim 5 has been amended to depend from Claim 3, and Claim 6 depends from Claim 3. Therefore, each of Claims 3, 5, and 6 includes all the limitations of amended Claim 1, as well as other limitations of particular utility, so each of Claims 3, 5, and 6 are patentably distinguished over Lemon in view of Cardarelli. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 3, 5, and 6 and pass these claims to allowance.

Claims 8 and 9

Applicant has amended Claim 8 to recite (emphasis added):

Appl. No. : 10/771,703
Filed : February 4, 2004

8. A method of positioning the head of a golf tee at a desired distance above the ground, comprising inserting an end portion of the golf tee into the ground until a depth of penetration is reached, the end portion having a cross-sectional area, the depth of penetration indicated by a first stop on the tee at which a person can feel a marked increase in the resistance to insertion, but yet can be readily inserted further, **the first stop formed by a first plurality of ribs extending along at least a first portion of the tee adjacent to and spaced upwardly from the end portion, the first portion of the tee including the first plurality of ribs having a first constant cross-sectional area larger than the cross-sectional area of the end portion**, the first stop providing an indication of the amount of tee extending above the first stop suitable for use in connection with a large golf club head.

Applicant submits that the combination of Lemon and Cardarelli does not disclose or suggest all the limitations of amended Claim 8. For example, the combination of Lemon and Cardarelli does not disclose or suggest a first stop “formed by a first plurality of ribs” where a “first portion of the tee including the first plurality of ribs ha[s] a first constant cross-sectional area larger than the cross-sectional area of the end portion,” as recited by amended Claim 8.

Applicant further submits that there is no suggestion to combine the teachings of Lemon and Cardarelli. Obviousness can only be established where there is some teaching, suggestion, or motivation to combine or modify the teachings of the prior art to produce the claimed invention. See In re Fine, 837 F.2d 1071 (Fed. Cir. 1988); M.P.E.P. § 2143.01, page 2100-130, May 2004. To support the Examiner’s assertion of obviousness, the Examiner must provide clear and particular findings as to the reason one skilled in the art, with no knowledge of the claimed invention, would have selected these components and combined them in the manner claimed. See, e.g., In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

There is no teaching or suggestion in the prior art that the tee of Lemon would benefit in any way from the indentations disclosed by Cardarelli. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). There is no suggestion in the prior art, including in either Lemon or Cardarelli, to combine the teachings of Lemon and Cardarelli by modifying the tee of Lemon to include the indentations disclosed by Cardarelli. Without a teaching or suggestion in the prior art of the desirability of the combination, the Examiner’s assertion that it would be obvious to one of ordinary skill in the art to provide the tee of Lemon with the indentations of Cardarelli is an

Appl. No. : 10/771,703
Filed : February 4, 2004

impermissible use of hindsight derived from the teachings of the present application. See, e.g., In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999).

Therefore, Applicant submits that amended Claim 8 is patentably distinguished over Lemon in view of Cardarelli. Applicant respectfully requests that the Examiner withdraw the rejection of amended Claim 8 and pass amended Claim 8 to allowance.

Claim 9 depends from amended Claim 8, so Claim 9 is also patentably distinguished over Lemon in view of Cardarelli. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 9 and pass Claim 9 to allowance.

Response to Rejection of Claim 7 Under 35 U.S.C. § 103(a)

In the July 28, 2005 Office Action, the Examiner rejects Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Lemon in view of Cardarelli and U.S. Patent No. 5,356,146 issued to Blosser (“Blosser”).

Applicant submits that Blosser does not teach or suggest the limitations of amended Claim 1 which are not taught or suggested by Lemon in view of Cardarelli. Applicant further submits that there is no suggestion in the prior art to combine the teachings of Lemon, Cardarelli, and Blosser. Therefore, Applicant submits that amended Claim 1 is patentably distinguished over Lemon in view of Cardarelli and Blosser.

Claim 7 depends from Claim 3, which depends from amended Claim 1. Therefore, Claim 7 includes all the limitations of amended Claim 1, as well as other limitations of particular utility. Applicant submits that Claim 7 is patentably distinguished over Lemon in view of Cardarelli and Blosser. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 7 and pass Claim 7 to allowance.

Comments on New Claims 10-14

Applicant has added new Claims 10-14. Applicant submits that no new matter has been added to the present application by addition of these new claims. Applicant respectfully requests that the Examiner consider the allowability of these new claims.

Summary

For the foregoing reasons, Applicant submits that Claims 1, 3, and 5-14 are in condition for allowance, and Applicant respectfully requests such action. If there are any remaining issues which the Examiner thinks can be resolved by telephone, the Examiner is invited to call Applicant’s representative, Bruce S. Itchkawitz, at 949-721-2924, or at the number listed below.

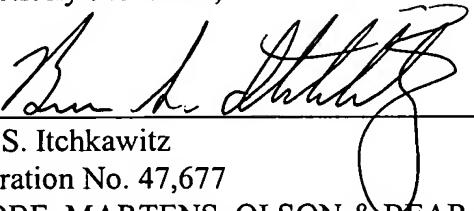
Appl. No. : 10/771,703
Filed : February 4, 2004

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

Dated: 4/8/05

By:


Bruce S. Itchkawitz
Registration No. 47,677
KNOBBE, MARTENS, OLSON & BEAR, LLP
Attorney of Record
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404

2050631
110805